

Appl. No. : 10/663,383  
Filed : September 16, 2003

### **REMARKS**

The March 9, 2006 Office Action was based on pending Claims 1–21. By this Response, Applicant is amending Claims 1, 4, 5, 9, 12–14, 20 and 21 and is cancelling Claim 17 without prejudice or disclaimer. Claims 2, 3, 6–8, 10, 11, 15, 16, 18 and 19 remain as originally filed.

Thus, after entry of the foregoing amendments, Claims 1–16 and 18–21 are pending and presented for further consideration. In view of the foregoing amendments and the remarks set forth below, Applicant respectfully submits that Claims 1–16 and 18–21 are in condition for allowance.

### **SUMMARY OF OBJECTIONS AND REJECTIONS**

The March 19, 2006 Office Action rejected Claim 17 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

The Office Action also rejected Claims 1, 12–14 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,426,284 to Doyle (“Doyle”).

Claims 2, 15, 18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Doyle in view of U.S. Patent No. 5,884,067 to Storm et al. (“Storm”). Claims 3–11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Doyle in view of U.S. Patent Application Publication No. 2002-0076206 to Hyatt (“Hyatt”). Claims 16 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Doyle in view of U.S. Patent Application Publication No. 2003-0163399 to Harper et al. (“Harper”).

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

The Office Action rejected Claim 17 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Office Action states that Applicant's specification does not contain a clear and concise description of the manner and process of taking an inventory when the device that is being inventoried is taken offline such that a skilled artisan can make and use the invention.

Appl. No. : 10/663,383  
Filed : September 16, 2003

Applicant respectfully traverses this rejection and the characterization of Applicant's specification. However, in an effort to expedite prosecution of the present application, Applicant has cancelled Claim 17 without prejudice or disclaimer.

**CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)**

The Office Action rejected Claims 1, 12–14 and 21 as being anticipated by Doyle. In view of the foregoing amendments and for at least the reasons set forth below, Applicant respectfully disagrees and requests reconsideration of Claims 1, 12–14 and 21.

**Independent Claim 1**

Focusing on amended independent Claim 1, in one embodiment of Applicant's invention a system is disclosed for operating a storage device. The system comprises a management server, a media agent connected to the management server, a storage device connected to the media agent, and a database connected to the management server.

The management server is configured: (1) to control the media agent to monitor for the addition or removal of a piece of media in the storage device and (2) to determine if the piece of media is either bar coded or non-bar coded. If the piece of media is non-bar coded, the media agent causes the storage device to read a media label stored as data in the non-bar coded piece of media, wherein the media label includes an identifier identifying the non-bar coded piece of media.

Doyle does not disclose the invention recited in amended Claim 1. Rather, Doyle is directed to an apparatus for locating and tracking information storage devices using only bar coded labels affixed to the outside of the storage device (see, e.g., Figures 4 and 5). That is, the tracking apparatus of Doyle identifies the location of the storage devices by communicating with a label reader (e.g., a bar code reader) that reads both a location label underneath a particular storage location and a tape label affixed to the storage device (see, e.g., col. 3, line 62 through col. 4, line 9; col. 4, line 49 through col. 5, line 36).

Appl. No. : 10/663,383  
Filed : September 16, 2003

Doyle does not disclose a management server configured to determine whether an inserted piece of media is bar coded or non-bar coded, as recited by amended Claim 1. Rather, all the pieces of media in the Doyle system are bar coded. Furthermore, Doyle does not disclose a media agent that causes the storage device to read data stored in the non-bar coded piece of media (e.g., electronic data) to determine an identifier of the non-bar coded piece of media. Rather, the system disclosed by Doyle reads an external bar code label affixed to the outside of the piece of media.

Because Doyle does not disclose each element of amended Claim 1, Applicant asserts that amended Claim 1 is not anticipated by Doyle, and Applicant respectfully requests allowance of Claim 1.

#### **Independent Claims 12, 13 and 21**

Amended independent Claim 12, 13 and 21 are believed to be patentably distinguished over Doyle for reasons similar to those set forth with respect to the patentability of independent Claim 1 and for the different aspects recited therein.

#### **Dependent Claim 14**

Claim 14 depends from independent Claim 13 and is believed to be patentably distinguished over Doyle for the reasons set forth above with respect to Claim 13 and for the additional features recited therein.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Office Action rejected Claims 2, 15, 18 and 20 as being unpatentable over Doyle in view of Storm. Claims 3–11 were rejected as being unpatentable over Doyle in view of Hyatt. Claims 16 and 19 were rejected as being unpatentable over Doyle in view of Harper.

In view of the foregoing amendments and for at least the reasons set forth below, Applicant respectfully disagrees and requests reconsideration of the aforementioned claims.

Appl. No. : 10/663,383  
Filed : September 16, 2003

**Independent Claims 4, 5 and 9**

Amended independent Claims 4, 5 and 9 are believed to be patentably distinguished over the cited art for reasons similar to those set forth with respect to the patentability of independent Claim 1 and for the different aspects recited therein. For example, neither Doyle, nor Hyatt, nor a combination thereof, teaches or suggests a system having a management server configured to determine whether or not a piece of media added or loaded to a storage device is either bar coded or non-bar coded.

**Dependent Claims 2, 3, 6–8, 10, 11, 15, 16 and 18–20**

Claim 2 depends from independent Claim 1 and is believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 1 and for the additional features recited therein. For example, neither Doyle, nor Storm, nor a combination thereof, teaches or suggests a system having a management server configured to determine if a piece of media added or loaded to a storage device is either bar coded or non-bar coded.

Claim 3 depends from independent Claim 1 and is believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 1 and for the additional features recited therein. For example, neither Doyle, nor Hyatt, nor a combination thereof, teaches or suggests a system having a management server configured to determine if a piece of media added or loaded to a storage device is either bar coded or non-bar coded.

Claims 6–8 depend from independent Claim 5 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 5 and for the additional features recited therein. For example, neither Doyle, nor Hyatt, nor a combination thereof, teaches or suggests a system having a management server configured to determine if a piece of media loaded to a storage device is either a bar coded medium or a non-bar coded medium.

Claims 10 and 11 depend from independent Claim 9 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 9 and for the additional features recited therein. For example, neither Doyle, nor Hyatt, nor a combination thereof, teaches or suggests a system having a

**Appl. No.** : **10/663,383**  
**Filed** : **September 16, 2003**

management server configured to determine whether a test piece of media loaded to a storage device is either a bar coded medium or a non-bar coded medium.

Claims 15, 18 and 20 depend from independent Claim 13 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 13 and for the additional features recited therein. For example, neither Doyle, nor Storm, nor a combination thereof, teaches or suggests a method comprising determining whether or not a piece of media loaded in a slot of a storage device is bar coded.

Claims 16 and 19 depend from independent Claim 13 and are believed to be patentably distinguished over the cited art for the reasons set forth above with respect to Claim 13 and for the additional features recited therein. For example, neither Doyle, nor Harper, nor a combination thereof, teaches or suggests a method comprising determining whether or not a piece of media loaded in a slot of a storage device is bar coded.

#### **REQUEST FOR TELEPHONE INTERVIEW**

Pursuant to M.P.E.P. § 713.01, in order to expedite prosecution of this application, Applicant's undersigned attorney of record hereby formally requests a telephone interview with the Examiner as soon as the Examiner has considered the effect of the arguments presented above. Applicant's attorney can be reached at the general office number listed below.

#### **CONCLUSION**

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain, the Examiner is cordially invited to contact the undersigned such that the issues may be promptly resolved.

Appl. No. : 10/663,383  
Filed : September 16, 2003

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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